

REMARKS

It is respectfully requested that the present Request for Reconsideration be entered into the Official File. In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Request for Reconsideration be entered for purposes of an Appeal.

Applicants respectfully request the Examiner to reconsider the present application in view of the following remarks.

Status of the Claims

No claims are being amended, added or canceled. Thus, a listing of the claims is not needed.

Claims 5, 9 and 16 are withdrawn as being directed to non-elected subject matter. Claims 3 and 4 are objected to but are indicated as having allowable subject matter (see paragraph 4 of the outstanding Office Action). Further, claims 6, 8, 10-13 and 15 are allowed (paragraph 5 of the Office Action). Also, claims 7 and 14 were previously canceled without prejudice or disclaimer of the subject matter contained therein. This makes claims 1-6, 8-13 and 15-16 as pending in the present application.

Applicants respectfully request that the Examiner withdraw the only rejection and allow the currently pending claims.

Substance of the Interview

Applicants thank the Examiner for her time, helpfulness and courtesies extended to Applicants' representative during the Interview of April 1, 2009. The assistance of the Examiner in advancing prosecution of the present application is greatly appreciated. In compliance with M.P.E.P. § 713.04, Applicants submit the following remarks.

During the Interview, Applicants' representative referred the Examiner to the language in currently pending claim 1, paragraph [0022], and Figures 1-2 of the present specification, and compared the features of claim 1 to the disclosure in Jarpenberg '643 (US 2003/0144643 A1). After comparing the present invention with the disclosure, including Figure 4, of Jarpenberg '643, an agreement was reached that the instant rejection has been overcome. However, the Examiner stated that further search and consideration of references would be conducted after the present response was filed.

The merits of the outstanding rejection are discussed below.

Issues under 35 U.S.C. § 102(a)

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. 2003/0144643 A1 (hereinafter referred to as "**Jarpenberg '643**") (see paragraphs 2-3 of the Office Action). Applicants respectfully traverse and reconsideration is based on the following remarks.

During the above-mentioned Interview, an agreement was reached that the cited Jarpenberg '643 reference did not disclose all claimed features. Applicants add the following comments.

In the paragraph bridging pages 2-3 of the Office Action, the Examiner asserts Jarpenberg '643 still discloses all claimed features. However, Jarpenberg '643 does not disclose the claimed relation between the joint and elastic member. The relation between the "fixation location" and the "multi-strand elastic yarn" of Jarpenberg '643 is not the same as what is being claimed.

Applicants are claiming, in part:

"... the two sheet materials being discontinuously bonded to each other at joints in the extending direction of the extensible portion and a direction perpendicular to the extending direction of the extensible portion, the elastic members being arranged in the extensible portion avoiding the joints between the sheet materials and having both ends thereof fixed to the sheet materials ..."

In the Office Action, the Examiner refers Applicants to Figure 4 and paragraphs [0012] and [0047] of Jarpenberg '643. Figure 4 of Jarpenberg '643 is as follows:

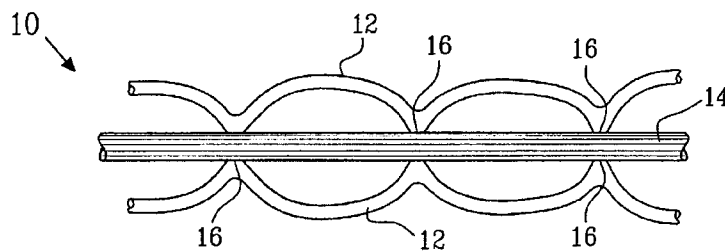


FIG.4

As can be seen in Figure 4, there are two "gatherable substrates" 12 that are bonded to the "multi-strand elastic yarn" 14 at "fixation locations" 16 (see also paragraph [0046] of the

reference). One multi-strand elastic yarn is made up of a plurality of strands (see paragraph [0036]).

Applicants also note other parts of Jarpenberg '643. In particular, paragraph [0018] of Jarpenberg '643 discloses that some of the strands of the yarn will delaminate and creates gap in the yarn through which the gatherable substrates (sheets) can be made to pass. If the fixation location falls on the delaminate gap, the sheet and the strands become fixed to each other. In this case, when the whole sheet is shrunken, the fixation location of the sheet and the strands does not change and remains at the same position.

In contrast, the elastic member of the present invention is not fixed to the sheet, other than at both ends of the elastic member. According to this structure, it is possible for the present invention to favorably avoid an increase in stiffness and allow the folds to be favorably deformed with more freedom under an external force, as described in paragraph [0022] (on pages 7-8) of the present specification.

Further, the cited Jarpenberg '643 reference fails to disclose or suggest the instantly claimed feature of "the elastic members being arranged in the extensible portion avoiding the joints between the sheet materials and having both ends thereof fixed to the sheet materials" (see instantly pending claim 1).

Based on the above, one of ordinary skill in the art understands that Jarpenberg '643 is directed to different embodiments that do not overlap in scope with pending claims 1 and 2. In this regard: "Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. §102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in

the claim.” *Net MoneyIN Inc. v. VeriSign Inc.*, 545 F.3d 1359, 88 USPQ2d 1751, 1758 (Fed. Cir. 2008) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193 (Fed. Cir. 1983)). Jarpenberg ‘643 does not disclose the elements are instantly recited or arranged. Thus, this rejection has been overcome.

Reconsideration and withdrawal of this only rejection is respectfully requested.

Claim Objections

Claims 3 and 4 stand objected to as stated in paragraph 4 of the Office Action. However, it is believed that this objection has been overcome as claims 1-2 are also allowable. Withdrawal of this objection is respectfully requested.

Withdrawn Subject Matter

Applicants respectfully note that should the Examiner find the elected product claims as allowable, then the process claims of making such products should be rejoined and found allowable in accordance of *In re Ochiai*. 37 USPQ2d 1127 (Fed. Cir. 1995). Further, the presently pending method claims depend on the product claims.

Conclusion

Based on the above, Applicants believe the present application is in condition for allowance. Thus, a Notice of Allowability is respectfully requested.

Application No. 10/569,204

Docket No.: 0445-0363PUS1

Art Unit 1794

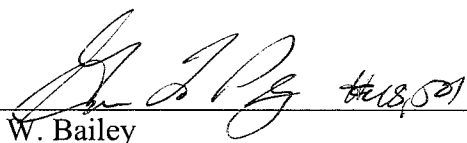
After Final Office Action of February 18, 2009

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: April 28, 2009

Respectfully submitted,

By 
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